

**REMARKS**

**I. Status of the Application and Claims**

Applicants respectfully request reconsideration and further examination in view of the following remarks.

Claims 12-16, 18, 71, and 73-77 are pending in this application. Claim 12 has been amended to delete "MMPKHCL/FLGL/FLI, (SEQ ID NO:13)" and claim 71 has been amended to add this recitation. Claims 12 and 71 now appear as they did prior to the Amendment filed June 13, 2005.

**II. Rejection Under 35 U.S.C. § 102**

The Office rejects claims 1-16, 18, 71, and 73-77 under 35 U.S.C. § 102(e) as allegedly anticipated by Goddard *et al.* (U.S. Patent No. 6,740,520) ("the '520 patent"). Office Action, p. 2. Applicants respectfully traverse this rejection.

As an initial matter, the '520 patent does not properly claim benefit under 35 U.S.C. § 119(e) to U.S. Provisional Application 60/191,015, and, therefore, cannot carry back its filing date to the '015 application. As required under 35 U.S.C. § 119(e), an application must claim priority to an earlier provisional application within 12 months of the filing date of the provisional application. A provisional application will automatically be abandoned 12 months after its filing date. M.P.E.P. § 201.04(b), p. 200-16, Rev. 2, May 2004. U.S. Application No. 09/964,994, which issued as the '520 patent, was filed more than one year after the '015 provisional application was filed. Furthermore, none of the priority applications listed on the face of the '520 patent claims benefit to the '015

provisional application.<sup>1</sup> Nor do any of the priority applications (other than the '015 application) appear to disclose the PRO19598 polypeptide. Thus, the '520 patent is not entitled to the priority benefit of the '015 provisional application under 35 U.S.C. § 119(e). And "an abandoned application by itself can never be a reference." *In re Wertheim*, 646 F.2d at 535, 209 USPQ at 562. Accordingly, for this reason alone, the rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Even if the '520 patent properly claimed priority to the '015 application, none of the priority applications, including the '015 application, provides 35 U.S.C. § 112, first paragraph, written description support for the '520 patent claims. Therefore, the earliest possible effective date for the '520 patent as a 35 U.S.C. § 102(e) reference is the September 26, 2001, filing date of the continuation-in-part (CIP) Application No. 09/964,994. As previously explained in the response filed June 29, 2004, the pending claims are entitled to a filing date of no later than that of Provisional Application 60/267,021, which is February 6, 2001. Accordingly, the '520 patent does not qualify as a prior art reference under 35 U.S.C. § 102(e).

Section 2136.03 of the M.P.E.P. explains how to determine the effective date of a U.S. patent under 35 U.S.C. § 102(e). Subheading IV of that section more specifically addresses how to determine the effective date when the 102(e) reference includes a CIP application in its chain of priority applications. According to the M.P.E.P.:

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must (A) have a right of priority to the earlier date under 35 U.S.C. 120 and (B) support the invention claimed as required by 35 U.S.C. 112, first

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<sup>1</sup> See **Exhibit D** (US2003/0082546), Application S.N. 09/941,992; **Exhibit E**, PCT/US00/08439 (WO 00/73454); and **Exhibit F**, PCT/US01/06520 (WO 01/68848).

paragraph. "For if a patent could not have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art'" under 35 U.S.C. 102(e). *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981).

M.P.E.P. § 2136.03. This is exactly the situation presented by the '520 patent. As set forth in the "Related U.S. Application Data" section on the front page of the '520 patent, Application 09/964,994, which issued as the '520 patent, is a "[c]ontinuation-in-part of application No. 09/941,992, filed on Aug. 28, 2001." (**Exhibit A**, see cover page of U.S. Patent No. 6,740,520.)

Applying the *Wertheim* analysis to the '520 patent, its earliest possible effective date is September 26, 2001, because at least one limitation of the '520 patent claims was not disclosed until Application 09/964,994 was filed on September 26, 2001. Independent claims 1-5 and 12 of the '520 patent are directed to nucleic acid molecules and recite the functional limitation "wherein said isolated nucleic acid encodes a polypeptide which is a receptor for and binds to the ligand polypeptide shown as SEQ ID NO:4." This functional limitation was added to the claims to overcome a written description rejection.<sup>2</sup> None of the applications in the chain of priority discloses the limitation "wherein said isolated nucleic acid encodes a polypeptide which is a receptor for and binds to the ligand polypeptide shown as SEQ ID NO:4."<sup>3</sup> Notably, Provisional Application No. 60/191,015 does not refer to the polypeptide ligand PRO3301 or provide the amino acid sequence of any ligand for the PRO19598 polypeptide, while none of the

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<sup>2</sup> See Amendment Under 37 C.F.R. § 1.111 dated May 7, 2003, pp. 9-10 (**Exhibit B**) and Amendment Under 37 C.F.R. § 1.111 dated September 2, 2003, pp. 8-9. (**Exhibit C**).

<sup>3</sup> See **Exhibit D** (US2003/0082546), Application S.N. 09/941,992; **Exhibit E**, PCT/US00/08439 (WO 00/73454); **Exhibit F**, PCT/US01/06520 (WO 01/68848); and **Exhibit G**, U.S. Provisional Application No. 60/191,015.

remaining priority applications discloses the PRO19598 polypeptide. Rather, the disclosure of PRO19598 being a "receptor for and bind[ing] to the ligand polypeptide shown as SEQ ID NO:4" was first introduced in the CIP application filed on September 26, 2001, which issued as the '520 patent. See **Exhibit A**, '520 patent, col. 2, lines 41-45, and col. 8, line 23.<sup>4</sup> Thus, the CIP application filed on September 26, 2001, is the first application in the chain of priority that could possibly provide 35 U.S.C. § 112, first paragraph, written description support for the '520 patent claim limitation "wherein said isolated nucleic acid encodes a polypeptide which is a receptor for and binds to the ligand polypeptide shown as SEQ ID NO:4." Accordingly, consistent with *Wertheim*, the effective date for the '520 patent as prior art under 35 U.S.C. § 102(e) is September 26, 2001, which is after the effective filing date of the pending claims. Because the '520 patent is not available as prior art, it cannot anticipate claims 12-16, 18, 71, and 73-77, and Applicants respectfully request that the Office withdraw this rejection.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request the examination on the merits of this application and the timely allowance of the pending claims.

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<sup>4</sup> Although col. 2 of the '520 patent refers to the PRO3301 polypeptide as SEQ ID NO:7, throughout the prosecution of the '520 patent Applicants referred to the PRO3301 polypeptide ligand as SEQ ID NO:4. See, e.g., Amendment Under 37 C.F.R. § 1.111 dated May 7, 2003, pp. 8 and 10 (**Exhibit B**).


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By: \_\_\_\_\_

  
Timothy B. Donaldson  
Reg. No. 48,592  
Tel: 571-203-2712  
Fax: 202-408-4400